

REMARKS

Claim Rejections

Claim 2 is rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. Claim 2 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1-3 are rejected under 35 U.S.C. § 102(b) as being anticipated by Barzilai et al. (5,434,946). Claims 1-3 are also rejected under 35 U.S.C. § 103(a) as being unpatentable over Su (6,396,675) in view of Dob et al. (4,734,012) and Evoy (5,713,030).

Amendments to Specification

Applicant has amended the Specification as noted above to cure the grammatical and idiomatic inaccuracies noted by the Examiner. It is believed that the foregoing amendments to the Specification overcome the outstanding objections thereto. No "new matter" has been added to the original disclosure by the foregoing amendments to the Specification.

Drawings

It is noted that the Examiner has accepted the drawings as originally filed with this application.

Claim Amendments

By this Amendment, Applicant has canceled claim 1 and has amended claims 2 and 3 of this application. Claim 4 has also been added. It is believed that the new and amended claims specifically set forth each element of Applicant's invention in full compliance with 35 U.S.C. § 112, and define subject matter that is patentably distinguishable over the cited prior art, taken individually or in combination.

The new claims are directed toward: a cooling fan with a built-in adjustable speed structure, comprising: a fan frame; a stator frame having a preset hole therein; a PCB board including control electronics, ***the PCB board being aligned***

with the preset hole; and a manual fan speed control interface partially extending though the preset hole to connect with a variable resistor and the control electronics.

Barzilia et al. teach a hair dryer 10 having a control circuit 12 connected to the heater 24 and element 22, as shown in Figs. 1 and 2. It is important to note that the control circuit 12 and the actuating means are "mounted within the hand grip 20 of the hair dryer 10." Col. 4, ll. 7-10. As a result, it cannot be said that the control interface is mounted in a preset hole in the stator frame. Furthermore, the control circuit 12 cannot be said to be aligned with such a preset hole.

Barzilia et al. do not teach a cooling fan with a built-in adjustable speed structure, comprising: a fan frame; a stator frame having a preset hole therein; a PCB board including control electronics, the PCB board being aligned with the preset hole; and a manual fan speed control interface partially extending though the preset hole to connect with a variable resistor and the control electronics.

It is axiomatic in U.S. patent law that, in order for a reference to anticipate a claimed structure, it must clearly disclose each and every feature of the claimed structure. Applicant submits that it is abundantly clear, as discussed above, that Barzilia et al. do not disclose each and every feature of Applicant's new and amended claims and, therefore, could not possibly anticipate these claims under 35 U.S.C. § 102. Absent a specific showing of these features, Barzilia et al. cannot be said to anticipate any of Applicant's new and amended claims under 35 U.S.C. § 102.

Su teaches a power supply 1 having a knob 112. However, the knob 112 is clearly shown in Fig. 1 as mounted on the outside of the housing of the power supply 1 in a position spaced apart from the fan 11; this location does not teach or suggest mounting the knob 112 in a preset hole in the strator frame. In addition, Fig. 3 clearly shows that the fan 11 is a conventional cooling fan. As admitted by the Examiner on p. 4 of the outstanding Office Action, Su fails to teach components integrated on a PCB or that the knob is connected to a variable resistor.

Dob et al. is cited as teaching a knob connected to a resistor, while Evoy is cited as teaching components integrated on a PCB. However, neither reference provides the above noted deficiencies. Namely, neither reference teaches or

suggests that the control interface is mounted in a preset hole in the stator frame or that the PCB is aligned with the a preset hole.

Even if the teachings of Su, Dob et al, and Evoy were combined, as suggested by the Examiner, the resultant combination does not suggest: a cooling fan with a built-in adjustable speed structure, comprising: a fan frame; a stator frame having a preset hole therein; a PCB board including control electronics, the PCB board being aligned with the preset hole; and a manual fan speed control interface partially extending through the preset hole to connect with a variable resistor and the control electronics.

It is a basic principle of U.S. patent law that it is improper to arbitrarily pick and choose prior art patents and combine selected portions of the selected patents on the basis of Applicant's disclosure to create a hypothetical combination which allegedly renders a claim obvious, unless there is some direction in the selected prior art patents to combine the selected teachings in a manner so as to negate the patentability of the claimed subject matter. This principle was enunciated over 40 years ago by the Court of Customs and Patent Appeals in In re Rothermel and Waddell, 125 USPQ 328 (CCPA 1960) wherein the court stated, at page 331:

The examiner and the board in rejecting the appealed claims did so by what appears to us to be a piecemeal reconstruction of the prior art patents in the light of appellants' disclosure. ... It is easy now to attribute to this prior art the knowledge which was first made available by appellants and then to assume that it would have been obvious to one having the ordinary skill in the art to make these suggested reconstructions. While such a reconstruction of the art may be an alluring way to rationalize a rejection of the claims, it is not the type of rejection which the statute authorizes.

The same conclusion was later reached by the Court of Appeals for the Federal Circuit in Orthopedic Equipment Company Inc. v. United States, 217 USPQ 193 (Fed.Cir. 1983). In that decision, the court stated, at page 199:

As has been previously explained, the available art shows each of the elements of the claims in suit. Armed with this information, would it then be

non-obvious to this person of ordinary skill in the art to coordinate these elements in the same manner as the claims in suit? The difficulty which attaches to all honest attempts to answer this question can be attributed to the strong temptation to rely on hindsight while undertaking this evaluation. It is wrong to use the patent in suit as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claims in suit. Monday morning quarterbacking is quite improper when resolving the question of non-obviousness in a court of law.

In In re Geiger, 2 USPQ2d, 1276 (Fed.Cir. 1987) the court stated, at page 1278:

We agree with appellant that the PTO has failed to establish a *prima facie* case of obviousness. Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching suggestion or incentive supporting the combination.

Applicant submits that there is not the slightest suggestion in either Su, Dob et al, or Evoy that their respective teachings may be combined as suggested by the Examiner. Case law is clear that, absent any such teaching or suggestion in the prior art, such a combination cannot be made under 35 U.S.C. § 103.

Neither Su, Dob et al, nor Evoy disclose, or suggest a modification of their specifically disclosed structures that would lead one having ordinary skill in the art to arrive at Applicant's claimed structure. Applicant hereby respectfully submits that no combination of the cited prior art renders obvious Applicant's new and amended claims.

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Summary

In view of the foregoing amendments and remarks, Applicant submits that this application is now in condition for allowance and such action is respectfully requested. Should any points remain in issue, which the Examiner feels could best be resolved by either a personal or a telephone interview, it is urged that Applicant's local attorney be contacted at the exchange listed below.

Respectfully submitted,

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